

3737 3305



TRANSMITTAL LETTER
(General - Patent Pending)

Docket No.
9872 (F52,519)

In re Application Of: In re Public Use Proceeding of: Ted Christopher

Serial No.
08/746,360

Filing Date
November 8, 1996

Examiner
F. Jaworski

Group Art Unit
3305

Title: **FINITE AMPLITUDE DISTORTION-BASED INHOMOGENEOUS PULSE ECHO ULTRASONIC IMAGING**

#49
5/30

TO THE ASSISTANT COMMISSIONER FOR PATENTS:

Transmitted herewith is:

APPLICANT'S OPPOSITION TO PETITIONER'S MOTION TO COMPEL CROSS-EXAMINATION OF APPLICANT'S REBUTTAL DECLARANTS

MAY 15 2001
TECHNOLOGY CENTER 85700

in the above identified application.

- ☒ No additional fee is required.
- ☐ A check in the amount of _____ is attached.
- ☒ The Assistant Commissioner is hereby authorized to charge and credit Deposit Account No. **19-3886/RCT** as described below. A duplicate copy of this sheet is enclosed.
- ☐ Charge the amount of _____
- ☒ Credit any overpayment.
- ☒ Charge any additional fee required.

Signature

Dated: May 4, 2001

Frank S. DiGiglio
Registration No. 31,346

SCULLY, SCOTT, MURPHY & PRESSER
400 Garden City Plaza
Garden City, New York 11530
(516)742-4343

I certify that this document and fee is being deposited on May 4, 2001 with the U.S. Postal Service as first class mail under 37 C.F.R. 1.8 and is addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.

Signature of Person Mailing Correspondence

Mishelle Mustafa

Typed or Printed Name of Person Mailing Correspondence

CC:



PATENTS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Public Use Proceeding of Ted Christopher

Applicant(s): Ted Christopher

Examiner: F. Jaworski

Serial No.: 08/746,360

Art Unit: 3305

Filed: November 8, 1996

Docket: 9872

For: FINITE AMPLITUDE DISTORTION-
BASED INHOMOGENEOUS PULSE
ECHO ULTRASONIC IMAGING

Dated: May 4, 2001

Assistant Commissioner for Patents
Washington, DC 20231

MAY 15 2001

TECHNICAL CENTER

APPLICANT'S OPPOSITION TO PETITIONER'S MOTION TO COMPEL CROSS-
EXAMINATION OF APPLICANT'S REBUTTAL DECLARANTS

Dear Sir:

In accordance with 37 C.F.R. § 1.638(a), Applicant submits this Opposition to Petitioner's Motion to Compel Cross-examination of Applicant's Rebuttal Declarants ("Motion to Compel"). Applicant respectfully requests that the Examiner deny Petitioner's motion.

On April 9, 2001, in compliance with the schedule in the pending public use proceeding as set forth in 37 C.F.R. §1.292(a), Applicant proffered the testimony of three (3) declarants, Kim A. Baker, Kevin J. Parker, Ph.D and Evan C. Under, M.D. in support of the Applicant's case-in-rebuttal.

On April 16, 2001, Petitioner filed an unauthorized motion to compel the cross-examination of the Applicants rebuttal witnesses. The Petitioner's request finds no justification in the rules or the schedule.

In the first instance, the public use proceeding is an *ex parte* proceeding. (See the institution and schedule of the public use proceeding at Exhibit A where it is stated that this is an *ex parte* case.)

The patent application process is, basically, an *ex parte* process. See Environmental Designs, Ltd. v. Union Oil Co. of CA, 713 F.2d 693, 698 (Fed. Cir. 1983). However, in a limited number of exceptions, the Patent Office provides members of the public with a limited opportunity to participate in the patent application process. In the present instance - that is, a Public Use Proceeding - the Patent Office provides a member of the public the opportunity to present evidence and testimony, subject to cross-examination, to attempt to establish a public use. 37 C.F.R. §1.292(a).

With respect to the rebuttal Declarations submitted by the Applicant, the Patent Office, simply adheres to the basic *ex parte* nature of the patent application process. Indeed, it is expressly stated in the Schedule for this proceeding that "this is an *ex parte* case." Consistent with this characterization, and in fact required by the *ex parte* nature of this case, neither the Schedule nor the Rules provide the Petitioner with the opportunity for cross-examination of Applicant's Declarants.

Notably, in this regard, the MPEP specifically distinguishes two types of public use proceedings: *ex parte* and *inter parte*. See MPEP §720. According to the MPEP, the distinction is an important one as petitioners afforded *inter parte* status are able to participate in public use proceedings "to a greater degree than in the *ex parte* situation." *Id.* For example, petitioners in an *inter parte* situation are able to inspect the application as a matter of right, a right that a petitioner afforded *ex parte* status does not hold because the *ex parte* petitioner "...stands in no better position than any other member of the public..." *Id.* An inter parties public use

proceeding is defined as one where the pending application is a reissue application (i.e. already providing a public basis).

Among the rights not granted to an *ex parte* petitioner in a public use proceeding is the right to cross-examine an Applicant's rebuttal declarants. Such implementation is because an *ex parte* public use proceeding is a unique procedural mechanism allowing a member of the public to invade the *ex parte* nature of the patent application process to introduce evidence related to an alleged public use; but only directed to establishing the public use. An *ex parte* public use proceeding is not a forum where members of the public may prematurely litigate the patentability of an application, as Petitioner advances by its motion. Thus, the Applicant submits that the only evidence subject to cross-examination in this proceeding is evidence presented to establish a public use; the Declarations submitted by Petitioners are such evidence. The Declarations submitted by Applicant, in contrast, are not being submitted to establish a public use, and thus these Declarants are not subject to cross-examination in this proceeding.

This is entirely consistent with the Patent Office's objective of preserving the *ex parte* nature of this proceeding. In laying out a schedule for testimony, nowhere does the MPEP make mention of a time period in which a petitioner may cross-examine rebuttal declarants.¹

Properly following the MPEP and underlying regulations (see 37 C.F.R. §1.292(a)), the Examiner did not contemplate cross-examination of the rebuttal Declarants as it is not included

¹ (A) Testimony for petitioner to close.....

[specify a date, e.g., January 10, 1997, which is approximately 60 days after the letter]

(B) Time for the application to file objections to admissibility of petitioner's evidence to close...

[specify a date which is approximately 20 days after date (A)]

(C) Time for the petitioner to file supplemental evidence to overcome objections to close 20 days from above date, i.e.,.....

[specify a date which is exactly 20 days after date (B), unless the date is a Saturday, Sunday or federal holiday, in which case use the next business day]

(D) Time for the applicant to request cross-examination of the petitioner's affiants to close.....

[specify a date which is approximately 20 days after the date (C)]

(E) Time for cross-examination of the petitioner's affiants to close.....

[specify a date which is approximately 30 days after date (D)]

in the Schedule for testimony sent to the Petitioner and Applicant in this proceeding. Indeed, its omission from the Schedule is due to the recognition that this public use proceeding is an *ex parte* situation, which notably, the Examiner took care to expressly indicate on the Schedule itself.

For the reasons set forth above, Applicant respectfully requests that the Examiner deny Petitioner's Motion to Compel Cross-Examination of Applicant's Rebuttal Declarants.

Respectfully Submitted,



Frank D. DiGiglio
Registration No. 31,346

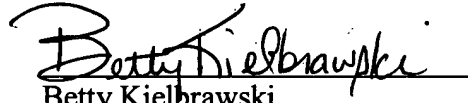
SCULLY, SCOTT, MURPHY & PRESSER
400 Garden City Plaza
Garden City, New York 11530
(516)742-4343
FSD:bk

PROOF OF SERVICE

In accordance with 37 C.F.R. §1.248, Applicant hereby certifies that a duplicate copy of this paper, APPLICANT'S OPPOSITION TO PETITIONER'S MOTION TO COMPEL CROSS-EXAMINATION OF APPLICANT'S REBUTTAL DECLARANTS, and all supporting materials have been served on Petitioner's attorney on May 4, 2001, via first class mail at the following address:

Joseph F. Hetz, Esq.
BRINKS HOFER GILSON & LIONE
P.O. Box 10395
Chicago, IL 60610

Dated: May 4, 2001


Betty Kielbrowski

SCULLY, SCOTT, MURPHY & PRESSER
400 Garden City Plaza
Garden City, New York 11530
(516) 742-4343
FSD:bk



LEOPOLD PRESSER
SCULLY, SCOTT, MURPHY & PRESSER
400 GARDEN CITY PLAZA
GARDEN CITY, NY 11530

In re Application of Ted Christopher :
Application No. 08/746,360 : PUBLIC USE PROCEEDING
Filed: November 8, 1996 :
Attorney Docket No. 9872 :

A Decision granting a petition to institute public use proceedings was mailed in the present application on February 25, 2000.

As set forth in 37 CFR 1.292(a), the conduct of this public use proceeding shall be in accordance with 37 CFR 1.671 - 1.685, as amended effective April 21, 1995. See Notice of Final Rule, 60 Fed. Reg. 14488 (March 17, 1995), corrections printed in 60 Fed. Reg. 16920 (April 3, 1995). The final rule notice, including corrections, was also published at 1173 Off. Gaz. Pat. & TM Office 36 (April 11, 1995). The complete text of the interference rules, including amendments, was published at 1173 Off. Gaz. Pat. & TM Office 384 (April 18, 1995). Appendix R of the MPEP (7th Ed.) (July 1998) also contains the complete text of the interference rules as amended effective April 21, 1995.

In conformance with the Decision mailed February 25, 2000, directing the institution of public use proceedings, the times for taking testimony are set as follows:

Schedule for testimony

1. Testimony for petitioner to close..... November 30, 2000
2. Time for the applicant to file objections to admissibility of petitioner's evidence to close..... December 20, 2000
3. Time for the petitioner to file supplemental evidence to overcome the objections to close 20 days from the above date..... January 10, 2001
4. Time for the applicant to request cross-examination of the petitioner's affiants to close..... January 30, 2001

5. Time for cross-examination of the Petitioner's affidavits to close..... March 1, 2001
6. Rebuttal testimony by applicant to close..... March 21, 2001 4TH

Schedule for filing and serving copies of record and briefs

One copy of each the petitioner's and the applicant's record and exhibits (See 37 CFR 1.653) is due..... April 20, 2001

Petitioner's brief is due..... May 20, 2001

Applicant's brief is due..... June 10, 2001

Applicant and petitioner may agree on a different schedule for testimony, records and briefs, provided the last brief is due no later than the date set forth above and provided a copy of the new schedule is filed by either applicant or petitioner.


A certified transcript of a deposition must be filed in the Patent and Trademark Office within one month after the date of deposition. 37 CFR 1.678.

SERVICE OF PAPERS

All further papers in this public use proceeding shall be served in accordance with 37 CFR 1.248.

Since this is an ex parte case, no oral hearing will be held. Attention is directed to MPEP Section 720.04 and 720.05 (7th Ed.) (July 1998).

Francis J. Jaworski
Primary Examiner
Technology Center Art Unit 3737


Francis J. Jaworski
Primary Examiner